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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Lainye Heiles

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INTELLECTUAL PROPERTY ADMINISTRATION  
FORT COLLINS, CO 80527-2400

EXAMINER

MILIA, MARK R

ART UNIT

PAPER NUMBER

2625

NOTIFICATION DATE

DELIVERY MODE

09/18/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/766,496	<b>Applicant(s)</b> HEILES ET AL.	
	<b>Examiner</b> Mark R. Milia	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13, 18-23 and 27-33 is/are pending in the application.
- 4a) Of the above claim(s) 14-17 and 24-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 18-23 and 27-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                            | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of claims 1-13, 18-23, and 27-33 (Group I) in the reply filed on 6/30/08 is acknowledged.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: In Fig. 1, the IM printer application **56** described in the specification is not located in the Mobile Print Server **20** as described in the specification and the same problem exists with the rendering application **48** not being located in the IM printer **34** as described in the specification. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be

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notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The disclosure is objected to because of the following informalities: On page 7, line 21 reference numeral **35** should be **25'**. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-13, 18-23, and 27-33 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication No. 2005/0102362 to Price et al.

Regarding claim 1, Price discloses a printing system comprising: an instant message server configured to process data received using instant message protocol (see Fig. 2 **218** and paragraph 38), an instant message printer application associated with the instant message server and configured to translate print data received in instant

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message protocol into a printable format (see Fig. 2 **99** and **208** and paragraphs 36 lines 7-9 and 44), and a printer associated with the instant message printer application, and configured to print the translated print data (see Fig. 2 **210** and paragraph 45 lines 1-3).

Regarding claim 12, Price discloses an instant messaging system comprising: an instant message server configured to process data using instant message protocol (see Fig. 2 **218** and paragraph 38) and an instant message printer application configured to translate print data received in instant message protocol into a printable format, and to forward the print data in the printable format to print hardware for printing (see Fig. 2 **99**, **208**, and **210**, and paragraphs 36 lines 7-9, 44, and 45 lines 1-3).

Regarding claim 13, Price discloses an instant message enabled printer comprising: a communications interface configured to transmit and receive data using instant message protocol (see Fig. 2 **99** and paragraph 38), an instant message printer application configured to translate print data received in instant message protocol into a printable format, and to forward the print data in a printable format (see Fig. 2 **99** and **208** and paragraphs 36 lines 7-9 and 44), and print hardware configured to receive print data forwarded from the instant message printer application, and to print a document from the forwarded print data (see Fig. 2 **210** and paragraph 45 lines 1-3).

Regarding claim 18, Price discloses a method of processing a document print request comprising: receiving an instant message print request from a requesting device via a network, the instant message print request containing document identification data and a destination address on the network (see paragraphs 30-31 and

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48 lines 11-14, reference shows that instant messages can be exchanged between a user computer or IM capable portable device and that a request to print a document can be sent from a user with information related to the document's location and the printer will then retrieve the document of the Internet or intranet and print the document, further the printer may query the user for needed information such as an IP address, subnet mask, or gateway address), generating a response instant message, with at least one associated document, in response to the instant message print request (see paragraphs 30-31), and transmitting the response instant message to the destination address on the network (see paragraphs 30-31 and 48 lines 11-14).

Regarding claim 27, Price discloses a method of printing a document requested via instant messaging protocol, the method comprising: receiving an instant message print request from an instant message compatible device (see paragraphs 36 and 38), parsing content information from the instant message print request (see paragraph 47 lines 4-6), and printing print content using the parsed content information (see paragraph 48 lines 16-20).

Regarding claim 32, Price discloses an instant messaging system comprising: means for processing data using instant message protocol (see paragraphs 36 and 38) and means for translating print data received in instant message protocol into a printable format, and means for forwarding the print data in the printable format to print hardware for printing (see Fig. 2 **99**, **208**, and **210**, and paragraphs 36 lines 7-9, 44, and 45 lines 1-3).

Regarding claim 33, Price discloses an message enabled printer comprising: a means for communication configured to transmit and receive data using instant message protocol (see paragraphs 36 and 38), a means for translating print data received in instant message protocol into a printable format, and forwarding the print data in a printable format (see Fig. 2 **99** and **208** and paragraphs 36 lines 7-9 and 44), and means for receiving print data forwarded from the instant message printer application, and printing a document from the forwarded print data (see Fig. 2 **210** and paragraph 45 lines 1-3).

Regarding claim 2, Price further discloses wherein the printer includes a processor and memory, wherein the memory includes, stored thereupon, and executable by the processor, logic that acts as the instant message printer application (see Fig. 2 **99** and **100** and paragraphs 34-35).

Regarding claim 3, Price further discloses a device having a processor circuit and memory coupled with the network and configured to communicate with both the instant message server and the printer, wherein the memory includes, stored thereupon, and executable by the processor, logic that acts as the instant message printer application (see Fig. 2 **99** and **100** and paragraphs 34-36, 38, and 44).

Regarding claim 4, Price further discloses wherein the instant message server is configured to communicate with the printer and the instant message server includes a processor and memory, wherein the memory includes, stored thereupon, and executable by the processor, logic that acts as the instant message printer application (see Fig. 2 and paragraphs 34-36, 38, and 44, the components of computer peripheral

device controller **99** shown in figure 2 act as an IM server as disclosed by the claim because it received as processes print data).

Regarding claim 5, Price further discloses wherein the instant message printer application is configured to extract print data from an instant message, and to format the extracted print data for printing (see paragraphs 32 and 44).

Regarding claim 6, Price further discloses wherein the instant message printer application is configured to extract a data reference from an instant message, and to retrieve referenced data from a file server (see paragraph 30).

Regarding claim 7, price further discloses wherein the file server is a remote server (see paragraph 30).

Regarding claim 8, price further discloses a mobile device having a print application configured to communicate with the instant message server using instant message protocol (see Fig. 2 **215** and paragraph 36).

Regarding claim 9, Price further discloses wherein the mobile device is configured to send an instant message print request including print data (see paragraphs 36 and 38).

Regarding claim 10, Price further discloses wherein the print data includes a document (see paragraphs 32 and 36 lines 7-9).

Regarding claim 11, price further discloses wherein the print data includes document retrieval information configured to enable the instant message printer application to retrieve a document for printing (see paragraphs 30 and 47 lines 4-6).



Regarding claim 19, Price further discloses wherein the response instant message includes document retrieval information enabling an instant message printer application to retrieve print content, in a printable format, from a file server for printing (see paragraph 30).

Regarding claim 20, Price further discloses parsing document retrieval information from the response instant message (see paragraph 47 lines 4-6), forwarding the document retrieval information to an instant message printer application where the print content is retrieved from a file server (see paragraph 48 lines 11-14), and delivering the retrieved print content to a printer (see paragraph 48 lines 11-14).

Regarding claim 21, Price further discloses wherein the response instant message includes the at least one associated document, and wherein the at least one associated document includes print content (see paragraphs 30-31 and 48 lines 11-14).

Regarding claim 22, Price further discloses delivering the print content to a printer in a printable format (see paragraphs 30 and 48 lines 11-14).

Regarding claim 23, Price further discloses wherein the print content is in a multi-purpose internet mail extension format (see paragraphs 38-41).

Regarding claim 28, Price further discloses sending a registration message to an instant message server indicating a printer is available for printing via instant message protocol (see paragraph 25).

Regarding claim 29, Price further discloses sending an instant message to the instant message compatible device containing the status of the instant message print request (see paragraph 25).

Regarding claim 30, Price further discloses wherein parsing content information from the instant message includes: identifying print content within the instant message (see paragraphs 47-48), identifying referenced print content within the instant message (see paragraphs 30 and 48 lines 11-14), retrieving the identified referenced print content (see paragraph 30), and translating the identified print content and the retrieved identified referenced print content into a printable format (see paragraphs 36 and 44).

Regarding claim 31, Price further discloses wherein printing content using the parsed content information includes forwarding translated print content to a network printer (see paragraphs 44-45).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571)272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached at (571) 272-7437. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mark R. Milia  
Examiner  
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